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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,316	12/04/2003	Chun Yuan Chang	P5204	2221

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EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT PAPER NUMBER

3632

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/730,316

Applicant(s)

CHANG, CHUN YUAN

Examiner

Naschica S Morrison

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8 and 9 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is the first Office Action for serial number 10/730,316, Rotatable book or file holder device, filed on December 4, 2003. Claims 1-9 are pending.

#### ***Specification***

The disclosure is objected to because of the following informalities: on page 4, line 2, "receive" should be --receiving--; on page 9, line 4 insert --a-- before "lower" and on line 11 delete "a" before "stability". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 1,789,838 to Powell. Powell discloses a holder comprising: a housing (1) including a chamber (recess formed in upper surface that receives member 19); a rotary member (5) rotatably received in the chamber and including a plurality of holes (14); a pole (2) including a lower portion secured to a central aperture of the rotary member and including an upper portion; and a plate (4) secured to the upper portion of the pole and including a plurality of holes (10) facing toward the holes (14) in the rotary member; wherein the housing includes a weight (19) disposed therein, the weight including a

Art Unit: 3632

space to rotatably receive the lower portion of the pole, and a bearing (ball indicated at 19) received in the space of the weight and engaged with the lower portion of the pole; wherein the housing includes a bottom board (horizontal surface on which 19 rests) and the weight is secured thereon.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell in view of U.S. Patent 4,946,127 to Kulaga. With regards to claims 5 and 8, Powell teaches the holder as applied above, but does not disclose the lower portion of the pole and central aperture of the rotary member being noncircular. Kulaga teaches a rotatable holder comprising a pole (21) having a noncircular lower portion engaged within a noncircular aperture (24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the lower portion of the pole and central aperture of the rotary member of Powell to be noncircular because one would have been motivated to prevent unwanted relative movement between the pole and rotary member as inherently taught by Kulaga.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Powell in view of Kulaga and further in view of U.S. Patent 1,695,322 to Day. With regards to

Art Unit: 3632

claim 9, Powell in view of Kulaga teaches the holder as applied above, but does not disclose the upper portion of the pole including a threaded portion with a fastener thereon. Day teaches a rotatable holder (Fig. 3) comprising a pole (11) having a threaded upper portion (38) having a fastener (40) thereon. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the upper portion of the pole of Powell to be threaded and include a fastener because one would have been motivated to provide a means for removably securing the plate on the pole as inherently taught by Day (page 2, lines 45-50).

#### ***Allowable Subject Matter***

Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


888158 to Glass; 1049886 to Manson; 1436544 to Starr; 1740118 to Rand;  
1766940 to Powell; 1789839 to Powell; 1930343 to Pettis; 2220189 to Wolters;  
2716410 to O'Hara; 4102069 to Eckert; 4370821 to Eichner; 4412621 to Eichner;  
5335796 to Sanford et al; 6000561 to Schumacher


Art Unit: 3632

The above references disclose rotatable holder devices relevant to the present invention.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 306-1113.

  
*Naschica S. Morrison*  
Patent Examiner  
Art Unit 3632  
**9/20/04**

  
ANITA KING  
PRIMARY EXAMINER

**Mini Lecture**

***Information to Pro Se Inventors  
Regarding responses to Office Actions***

**INTRODUCTION**

An examination of this application reveals that applicant may be unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application. The value of a patent is largely dependent upon skillful preparation and prosecution. Although the services of a registered patent attorney or agent is advised, the Office cannot aid in selecting an attorney or agent. 37 C.F.R. § 1.31; M.P.E.P. § 401. However, Applicant is encouraged to peruse the publication entitled "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

**DISCUSSION**

The following discussion provides general information for Applicant's benefit regarding an applicant's response, new matter, the period for response, and the certificate of mailing.

**I. Response by Applicant**

The applicant MUST respond to every ground of rejection and objection made in an Office action. 37 C.F.R. § 1.111. The applicant will generally present arguments that the examiner's rejections or objections were made in error; or amend the specification, drawings, and/or claims to overcome the rejection or objection. Amendments to the application may not introduce new matter. 37 C.F.R. § 1.118.

Unless the Office explicitly requests the return of a paper, all papers mailed to the applicant are intended to be kept by the applicant for his own records. **The response must be signed by ALL applicants.** 37 C.F.R. § 1.33.

The response must be identified by the Serial Number of the Application, the Art Unit, and the name of the examiner. An example follows:

Appl. No: XX/YYY,YYY  
Applicant: James Q. Inventor  
Filed : April 19, 2003  
Title : Bucket with Handle  
Art Unit: 3632  
Examiner: John Doe

#### *A. Arguments*

Should the applicant disagree with the examiner's position, the applicant should distinctly and specifically point out the supposed errors in the examiner's action with arguments under the heading "Remarks" in the response. 37 C.F.R. § 1.111. In addition, the applicant must discuss the references cited by the examiner that explain how the claims avoid the references or patentably distinguish from them. *Id.*

#### *B. Amendments to the Specification*

An amendment to the specification may remove a rejection or objection. Any amendment to the specification must be made by replacement of the entire paragraph/section. Additions to the specification should be underlined. Any deletions from the specification should be ~~stricken~~ through. Applicants must provide a marked-up version of the same paragraph or section showing changes. Clear instructions must be provided for the location of the amendment entry (e.g., paragraph number, page/line number). Deletion/Addition of an entire paragraph only requires an instruction to delete/add – no marked-up version required for deleted/added items. 37 C.F.R. § 1.121.

It is not necessary to submit a new specification unless one has been required by the Examiner.

Art Unit: 3632

*An amendment to the specification should appear as follows:*

Please replace paragraph beginning at page 5, line 15, with the following rewritten paragraph:

-- In the construction of the bucket of this invention, various materials have been selected ~~and~~ which offer a number of diverse properties and allow for varied functions of the article. For caustic solutions, the bucket can be made of a durable ~~polymer~~ plastic material. Where an aesthetic appeal is desired, the bucket can be any ~~of~~ one of many attractive colors. The following listing of properties serves to define possible uses for the buckets. --

#### *C. Amendments to the Claims*

An amendment to the claim may remove a rejection or objection. *Any amendment to the claims must be made by replacement of the entire claim and the provision of a new copy of all remaining claims.* Applicants must provide a marked-up version of the same claim showing changes. Additions to the claim should be underlined. Any deletions from the claims should be shown with a line striking through the deletions, i.e., ~~four~~ legs. Deletion/Addition of an entire claim only requires an instruction to delete/add – no marked-up version required for deleted/added items. 37 C.F.R. § 1.121. Parenthetical information is to be provided after each claim number to indicate how many times the claim has been amended (e.g., "(Once Amended)", "(Twice Amended)", etc ...) or that the claim is an "original" claim. If a claim has been cancelled, then the claim number should be provided with the word cancelled written beside it. 37 C.F.R. § 1.119.

For example, if a claim to a chair was originally written:

1. A chair comprising a horizontal seat, a vertical back, and a plurality of vertical support members.

An amended version of this claim might then be written as follows:

1. (Once Amended) A chair comprising a horizontal seat, a

Art Unit: 3632

vertical back, and ~~a plurality of four vertical support members~~ legs attached to said seat.

In this example, the words "a plurality of" and "support members" have been deleted from the claim. The words --four-- and --legs attached to said seat-- have been inserted.

The listing of claims will replace all prior versions, and listings, of claims in the application. An example follows:

**Listing of Claims:**

Claims 1-4 (canceled)

Claim 5 (original): A bucket with a black handle.

Claim 6 (original): A bucket of claim 5 wherein the handle is metal.

Claim 7 (withdrawn)

Claim 8 (currently amended): A bucket made of ~~yellow~~ green plastic.

Claim 9 (previously amended): A bucket of aluminum-coated galvanized metal.

Claim 10 (previously added): A bucket having a circumferential upper lip.

Claim 11 (new): A plastic bucket having a blue handle.

***D. Drawing Corrections***

Finally, correction of the drawings may remove a rejection or objection.

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be

Art Unit: 3632

labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

### **Annotated Drawing Sheets**

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

## **II. New Matter**

As previously mentioned, no amendment to the specification, claims, or drawings may introduce new matter. 37 C.F.R. § 1.118. "New matter" constitutes any material which meets the following criteria:

- (1) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- (2) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

Art Unit: 3632

See M.P.E.P. § 706.03(o). For example, in the amendment to the claim discussed above, the new limitation of "four legs" would not constitute new matter if the specification or drawings originally described the inclusion of four legs on the chair.

### III. Period For Response

An Office action generally sets a time period in which the applicant has to respond to every rejection and objection (called a shortened statutory period). 37 C.F.R. § 1.134. This time period for response appears on the cover letter (form PTO-326) of the Office action. Usually, a 3 month shortened statutory period is set. M.P.E.P. § 710.02(b). The applicant's response must be received within the time period listed on the cover letter, or the application will be held abandoned. 37 C.F.R. § 1.135.

Currently, the Office allows the time period for response to be extended past the shortened statutory period up to a maximum of 6 months (called the maximum 6 month statutory period). In order to extend the period of response past the shortened statutory period, a request for an extension of time and payment of the appropriate fee is required. 37 C.F.R. § 1.136. The request must state that it is for "an extension of the period for response under 37 C.F.R. § 1.136(a)." The following table lists the required fees for extensions of the shortened statutory period:

Months Past Response Date	Fee Due (Small / Large Entity)
Response within Time Allowed	None / None
1 Month	\$55 / \$110
2 Month	\$210 / \$420
3 Month	\$475 / \$950
4 Month	\$740 / \$1,480
5 Month	\$1005 / \$2,010

It is important to note that no extension of time is permitted that extends the period for response past the maximum 6 month statutory period. Responses received after the maximum 6 month statutory period will be held abandoned. 37 C.F.R. § 1.135. Three examples are provided:

Example 1:

A complete response is filed four months and one day after the mailing date of an Office action. The Office action sets a **3 month** shortened statutory period for response. The response must be accompanied by a fee in the amount of \$210.00 (for a small entity; \$420.00 for a large entity) for a 2 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 2:

A complete response is filed five months and one day after the mailing date of an Office action. The Office action sets a **2 month** shortened statutory period for response. The response must be accompanied by a fee in the amount of \$740 (for a small entity; \$1,480 for a large entity) for a 4 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 3:

A complete response is filed six months and one day after the mailing date of an Office action. The Office action sets a **3 month** shortened statutory period for response. The response is held abandoned even if accompanied by a fee and a request for an extension of time. Remember, extensions of time may not be used to extend the period for response past the maximum 6 month statutory period. 37 C.F.R. § 1.135.

#### IV. Certificate of Mailing

To ensure that the Applicant's response is considered timely filed, it is advisable to include a "Certificate of Mailing" on at least one page of the response. See 37 C.F.R. § 1.8. This "Certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-450" on  
(Date of Deposit).  
(Name of applicant, assignee, or Registered Representative)  
(Signature)  
(Date)

This "Certificate" may appear anywhere on the page, and may be handwritten or typed. *Id.* It MUST be signed by the person who actually deposits the paper with the Postal Service, and the date MUST be the actual date on which it is mailed. *Id.*

For the purpose of calculating extensions of time, the date shown on the certificate will be used as the date on which the paper was received by the Office, regardless of the date the Postal Service actually delivers the response. In this way, postal delays would not affect the extension-of-time fee.

Furthermore, Applicant is encourage to include with the response a self addressed and stamped postcard completely itemizing the papers submitted with applicant's response. See M.P.E.P. § 503. When the response is received by the Office, the postcard is date-stamped and returned to the applicant. *Id.* This is an applicant's best indication of the date the Office received the response and if all of the papers submitted have been received.

### **CONCLUSION AND CAVEAT**

The above discussion is not intended to be an exhaustive list of all the topics that may be relevant to this particular Application. The information was provided to familiarize Applicant with the portions of a response that have historically caused problems for *pro se* inventors.

Art Unit: 3632

Furthermore, even if Applicant's response is in accordance with the information provided above, there is no guarantee that every requirement of the patent laws (35 U.S.C. §§ 1-376), patent rules (37 C.F.R. §§ 1.1-150.6), and Patent Office policy (M.P.E.P. §§ 101-2591) has been met. The adequacy of a response is determined on a case-by-case basis. See 37 C.F.R. § 1.111; M.P.E.P. § 714.02.